

### **REMARKS**

By this amendment, previously presented claims 23-25 and new claims 26-47 are pending.

#### **Claim Rejections**

The Office Action rejected claim 23 as being unpatentable over U.S. Patent Number 5,058,940 to Hart, in view of U.S. Patent Number 5,087,090 to Humphrey et al. or U.S. Patent Number 4,055,361 to Moses. The Office Action rejected claims 24 and 25 as being unpatentable over Hart in view of either Humphrey et al. or Moses, and United States Patent Number 3,869,901 to Neary.

Claim 23 is directed to a deadbolt mechanism that includes a lockout mechanism. The lockout mechanism includes a shaft with a head portion and a shaft housing with a collar. The head portion of the shaft includes one or more depressions. The head portion of the shaft can be moved into and out of nesting engagement with the collar such that when the head portion is nested in the collar, the one or more depressions in the head portion engage one or more portions of the collar to prevent rotation of the shaft. Claim 25 recites that the shaft includes a set of depressions and the collar includes a set of protuberances. The depressions in the shaft and the protuberances of the collar can be placed in an interlocking relationship to prevent operation of the deadbolt.

The Hart patent shows a lockout mechanism that includes a roll pin 128 disposed through a tail piece or shaft and a slot 134 disposed in a tubular extension. The Office Action asserts that the parts of the Hart lockout mechanism could be reversed to meet the limitations of claims 23 and 25. The Office Action also cites US Patent No. 5,087,090 to Humphrey et al. or US Patent No. 4,055,361 to Moses for disclosure of a depression in a shaft that receives a protrusion. The stated motivation for combining the teachings of Humphry et al. or Moses with Hart is that “the collar of Hart would not be weakened by the depressions therein.”

Applicant respectfully points out that the parts of the Hart reference cannot be merely reversed to meet claims 23 and 25. Clearly, the roll pin 128 and the slot 134 in the Hart locking mechanism cannot merely be reversed. The roll pin 128 would be eliminated entirely, the slot 134 would be replaced by protrusions, and the tail piece or shaft would have to be modified to include a depression.

*Prima facie* obviousness can only be established when motivation to combine is found explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP § 2143.01. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” MPEP § 2143.01, *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references). Applicant points out that the Office Action has not presented any evidence that the asserted motivation is recognized in the prior art. The modification suggested by the Office Action would require adding depressions to the shaft, which would weaken the shaft. The Office Action has not established that one having ordinary skill in the art would be motivated to make the shaft weaker, in order to allegedly make a collar stronger. Motivation to combine the teachings of Humphrey et al. or Moses with the teachings of Hart has not been established. Independent claims 23 and 25 are in condition for allowance. Claim 24 depends from claim 23 and is allowable for at least the reasons claim 23 is allowable.

#### **New Claims**

New claims 26-46 have been added and are allowable for at least the following reasons.

Claim 26 recites that a head portion of a shaft can be selectively moved into nesting engagement with said collar such that when head portion is nested within the collar, one or more depressions engage one or more protrusions of the collar. The shaft can also be moved such that the head portion is disposed completely outside collar, thereby allowing rotation of the shaft. The applied references do not disclose or suggest a shaft head portion that can be moved completely outside a collar.

Claim 33 recites a shaft engaging collar that includes at least one protrusion that is formed integrally with the collar and extends radially inward from an inner circumferential surface of the collar. This feature is not disclosed or suggested by the applied references.

Claim 38 recites a shaft engaging collar that includes at least one protrusion that is formed integrally with the collar and has a substantially constant cross-section in a direction of an axis of the collar. This feature is not disclosed or suggested by the applied references.

Claim 42 recites a shaft engaging collar that includes at least one protrusion that is formed integrally with the collar and extends along an entire thickness of the collar. This feature is not disclosed or suggested by the applied references.

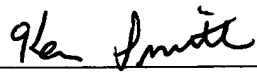
Claim 46 recites a shaft that connects at least two deadbolt manipulation mechanisms. The shaft includes a head portion with one or more depressions that extend along an entire thickness of the head portion. This feature is not disclosed or suggested by the applied references.

### **CONCLUSION**

Applicants respectfully submit that the application is in condition for allowance.

Respectfully submitted,

Date: September 18, 2006

By:   
Kenneth J. Smith  
Reg. No. 45,115  
Customer No. 24024  
(216) 622-8674  
ksmith@calfee.com